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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,258	02/09/2004	Valerie de la Poterie	05725.0598-01	7152
22852	7590	02/23/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			CHANNAVAJALA, LAKSHMI SARADA	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/773,258

Applicant(s)

POTERIE ET AL.

Examiner

Lakshmi S. Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### DETAILED ACTION

Receipt of IDS dated 8-20-04, preliminary amendment and remarks dated 2-9-04 is acknowledged.

Claims 1-31 are pending in the instant application.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 5,945,095. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims and the instant claims recite a cosmetic composition comprising at least one fatty substance and a non-aqueous dispersion of surface-stabilized polymer particles in at least one liquid fatty substance, wherein the polymer particles being surface stabilized by surface-stabilizing polymer. While the instant claims recite, "for coating keratin fibers", patented claims are also identical in scope because the latter mention the use of eye make up and lengthening

the eyelashes. Patented claims do not specifically mention the limitations such as specific weight percentages, viscosity of the polymer of the instant claims. However, the patent uses the same polymers for dispersion, stabilization and mentions the viscosity of 3-30 Pa.S (see patented claim 42). Accordingly, it would have been obvious for one of an ordinary skill in the art to optimize the amounts of the polymers and adjust the viscosity of the composition of the patented claims depending on the polymer or oil or the active agent so as to achieve the desired cosmetic effect.

2. Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,361,782. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the patented claims and instant claims recite a composition comprising a liquid fatty phase in which surface-stabilized polymer particles are dispersed. While the instant claims recite, "for coating keratin fibers", patented claims recite for skin, both limitations reflecting intended use and thus not patentable distinct. Further, patented claims state anhydrous composition; instant dependent claim 26 also recites anhydrous composition. Similarly, instant dependent claims recite dyestuffs that are claimed in the independent claim of the patent. While patented claims do not specifically mention the limitations such as specific weight percentages, viscosity of the polymer of the instant claims, the patented claims use the same polymers for dispersion, stabilization and therefore it would have been obvious for one of an ordinary skill in the art to optimize the amounts of the polymers and adjust the viscosity of the

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composition of the patented claims depending on the polymer or oil or the active agent so as to achieve the desired cosmetic effect.

Claims 1-31 are directed to an invention not patentably distinct from claim 1-21 of commonly assigned US 6,361,782. Specifically, as explained above, both the instant claims and the patented claims are directed to a composition comprising a surface stabilized polymer particles dispersed in a fatty liquid phase; and both sets of claims employ the same polymers and fatty materials to prepare the dispersion.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned US 6,361,782, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 749747 A1. Examiner notes that English equivalent of the EP 749747 is U.S. patent 5851517, since both EP and US patents claim priority over the same French Application. Therefore the teachings of US reference are relied upon.

EP teaches a composition containing a dispersion of surface stabilized polymer particles in a non-aqueous medium. EP suggests using polymers such as those used for nail polish or mascara (col. 1, lines 10-20 and col. 8 of US patent). EP teaches the

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same polymers i.e., acrylic or vinyl radical copolymers etc., such as those claimed in the instant (col. 2) and the non-aqueous liquid components such as natural, synthetic, carbon-based or hydrocarbon based oils (col. 3). EP further teaches the stabilizers such as sequential or grafted block copolymers, with 2-30% by weight of the stabilizer (col. 5 through 6). EP fails to teach the viscosity of the composition, as claimed in the instant. However, EP teaches various formulations such as gels (example 13), milky dispersion (example 8), and oils etc., which are different in their viscosities. Further, examiner also notes that instant specification states that the polymer preparation of the instant invention is carried out in the same manner as described in EP (pages 13, lines 18-21) and the examples that are within the scope of instant invention also utilize the same polymer dispersion as described in example 7 of EP (see the description of examples on page 25, lines 1-25). Accordingly, absent showing evidence on the contrary, because EP teaches the same polymers, solvents, stabilizers and other cosmetic ingredients in their composition, the cosmetic compositions of EP exhibit the same viscosity as that claimed. EP suggests preparing the composition as a transparent, translucent or opaque dispersion, and use for primarily as hair sprays or for eye lashes treatment (col. 2, lines 25-29, col. 6, lines 44-59). Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare the claimed dispersions of surface stabilized polymer particles in a liquid fatty phase with the desired consistency of the composition, with an expectation to achieve a stable composition that can be effectively used for treating hair or eyelashes.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being obvious over US 6,361,782 ('782).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

'782 teach a cosmetic composition comprising a surface stabilized polymer dispersed in a liquid fatty phase and teaches the same polymers and fatty materials for preparing the dispersion. '782 teaches at least 2% polymers (col. 3, lines 55-67) so as to form a film and trap cosmetic additives such as dyestuffs. Instant claims also recite at



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least 2% polymer concentration and for the same "film-forming" purposes. While '782 fails to teach the claimed viscosity, absent evidence to the contrary, the claimed viscosity is implicit to the composition of '782 because the reference also teaches the same polymers, fatty materials and in same amounts. '782 teach the composition for skin whereas instant composition recites for hair. However, the limitation "for coating keratin fibers" is intended use. On the other hand, the polymer so f '782 also forms films on skin and thus coat the skin as well as the hairs covering the skin. Accordingly, using the composition of '782 for coating keratin fibers would have been obvious for one of an of an ordinary skill in the art with an expectation to achieve an film-forming polymer that successfully traps actives such as dyes and thus deliver them effectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -6.30 PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala  
Examiner  
Art Unit 1615  
February 22, 2005